

Remarks/Arguments:

Claims 1 – 28 and 33 – 112 are pending in the case.

The Office Action objected to claim 103, which has been amended to depend on claim 101.

The Office Action has rejected all claims under 35 USC 103(a) as being obvious over U.S. Patent No. 6,115,509 to Yeskel in view of U.S. Patent No. 5,819,236 to Josephson.

The Examiner's Rejections Under 35 U.S.C. 103(a) Should Be Withdrawn

A. The Office Action Has Not Met the Burden of Establishing a Prima Facie Case of Obviousness With Respect to Independent Claims 1, 18 and 89.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. The Office Action Does Not Properly Communicate The Basis For the Rejection.

All rejections should be completely and clearly communicated so that the applicant can be given a fair opportunity to reply. See, generally, MPEP 707.07; see also MPEP 706.02(j). A rejection under Section 103 must meet certain specific requirements:

After indicating that the rejection is under **35 U.S.C. 103**, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

MPEP 706.02(j).

The initial burden is on the examiner to provide an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. MPEP 2142:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP 2142 (emphasis added).

The Office Action states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the capture of the data structures of on-us item, a cash letter and all items database as taught in Josephson into Yeskel in order to provide the storing and archiving system" (emphasis added). Applicant submits the Office Action does not include a clearly stated, convincing line of reasoning as to the motivation to combine the references. The stated rationale, "to provide the storing and archiving system," is vague and indefinite and therefore, denies applicant a fair opportunity to respond.

2. There Is No Suggestion or Motivation To Combine Yeskel and Josephson

The MPEP provides that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). See MPEP 2143.01.

The rationale asserted by the Office Action for combining the references, i.e., “providing the storing and archiving system,” is not a proper rationale for combining the references. It is not based on the nature of the problem to be solved, the teachings of the prior art or knowledge of persons of ordinary skill in the art. It is simply a restatement of the general functions provided by the Yeskel reference. Applicant’s understanding of the Office Action’s reasoning for the motivation to combine the disclosures of Yeskel and Josephson is “to provide the storing and archiving system.”

Indeed, there is no suggestion or motivation to combine Yeskel with Josephson because Yeskel is directed to a system and method of identifying images of items, such as bank checks, that are of suspect quality, whereas Josephson is directed to a system and method for providing advance notice of presentment returns due to account restrictions. A person skilled in the art of check image processing would not be motivated to consider teachings related to check presentment in order to improve the method of identifying images of suspect quality.

B. Even if The Yeskel and Josephson References Were Properly Combinable, The Combined References Do Not Disclose All The Elements of The Claimed Invention, As Set Forth in Claims 1, 18 and 89.

1. The Combination of Yeskel and Josephson Does Not Suggest the Use of Multiple Data Structures for Transaction Data.

The Yeskel and Josephson references, even if properly combinable, which they are not, do not disclose all of the elements of Claims 1, 18 or 89. The Office Action correctly states that Yeskel teaches a capture system that produces “one or more digital images of a document such as a check,” namely, images of the front and back of the checks. The Office Action then asserts that “[t]his suggests multiples [sic] data structures.” Applicant disagrees.

First, the multiple data structures limitation of Claims 1, 18 and 89, and the claims that depend thereon, are directed to *transaction data archive* element of the Claims. Transaction data is information relating to a financial transaction, such as a check, for which images may also be captured and stored. In contrast, the so-called “data structures” (i.e., images of the front and back side of a check) assertedly suggested by Yeskel are directed to *image data*. Thus, even if Yeskel’s teaching of producing images of the front and back sides of a check does suggest “multiple data structures,” with which Applicants disagree, Yeskel still does not suggest a *transaction data archive* having multiple data structures.

Second, the Yeskel reference, in fact, contains no disclosure whatsoever of the number (a single or multiple) of data structures that are used to archive transaction data. The disclosure of a capture system that produces front and back images of a check does not suggest multiple data structures any more than it suggests a single data structure. As is known to those ordinarily skilled in the art, data comprising front and back images of a check may be stored in either a single data structure or multiple data structures. Thus, Applicant disagrees with the Office

Action's conclusion that the disclosure of producing front and back images suggests multiple data structures, for either a transaction data or image data archive.

2. The Combination of Yeskel and Josephson Does Not Suggest The Use of An On-Us Items Data Structure, A Cash Letter Items Data Structure and An All Items Data Structure.

The Office Action also states that Josephson teaches an "on-us item," a "cash letter," and "an all items database." The Office Action then asserts, "This suggest [sic] multiple data structure [sic] like on-us item, a cash item and an all items database." Once again, the Office Action does not properly communicate the basis for the rejection thereby depriving Applicant of a fair opportunity to reply.

In addition, Yeskel's disclosure of generating digital images of the front and back of a check does not make obvious to one of ordinary skill in the art at the time of the invention the use of a transaction data archive comprised of an on-us items data structure, an all items data structure and a cash letter items data structure. It is the use of these claimed multiple data structures that provides the advantages afforded by the present invention. As discussed in the specification, it is the use of separate data structures for all items, on-us items, which are items drawn on the processing bank, and cash letter items, which are items drawn on a financial institution other than processing financial institution, that allows for quicker and more efficient storage and retrieval of item transaction data.

Moreover, to the extent that the Office Action is taking the position that Josephson's disclosure of an "on-us item," a "cash letter," and "an all items database" suggests the claimed limitation of "a transaction data archive comprised of an on-us items data structure, an all items data structure and a cash letter items data structure," Applicant disagrees. Indeed, if anything,

Josephson suggests the use of a *single data structure*, namely, the “all items database” to store information pertaining to both on-us items or cash letter items.

In summary, Yeskel and Josephson, even if properly combinable, do not teach or suggest all of the limitations of Claims 1, 18 or 89. Specifically, Yeskel and Josephson do not teach a *transaction data archive* having “multiple data structures” or being comprised of “an on-us items data structure, an all items data structure and a cash letter items data structure.”

Claims 2-17, all of which depend on Claim 1, and Claims 19-28, 33-88 and 90-112, which depend on Claim 18, are allowable for the same reasons that Claims 1 and 18 are allowable.

In addition, Claim 3 adds the limitation that the *image data* archive includes and on-us items image database and a transit items image database. As discussed in the specification, an on-us item is an item such as a check that is drawn on the financial institution that is also capturing the item, and a transit item is an item such as a check that is drawn on a financial institution other than the financial institution that is capturing the item. The Office Action rejects Claim 3 incorrectly asserting that Yeskel teaches an “image data archive subsystem [that] includes an on-line items image database and a transit items image database.” Again, the portion of Yeskel cited to support this statement is Figure 3, item 27, “archive storage devices.” Yeskel, however, never distinguishes between, or even mentions, the storage of image data for on-us items versus the storage of image data for transit items. Thus, Claim 3 is allowable for this reason as well.

Conclusion

Applicant believes that the rejections have been successfully overcome, and the application has been placed in condition for immediate allowance of Claims 1 – 28 and 33 – 112. Such action is respectfully requested. However, if any issue remains unresolved, Applicant's attorney would welcome the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



Jeffrey R. McFadden
Registration No. 46,916
Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0378
336-721-3730

Date: 19 Oct 2004
File No.: W3688-025 (formerly S4770-103)